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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,965	11/17/2000	Elizabeth M. Denholm	IT 106	7982

7590 04/01/2002

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EXAMINER
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MELLER, MICHAEL V

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 04/01/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/715,965

**Applicant(s)**

DENHOLM ET AL.

**Examiner**

Michael V. Meller

**Art Unit**

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

It is noted that applicants elected chondroitinase AC as their enzyme and cancer  
as the disorder.

The text of those sections of Title 35, U.S. Code not included in this action can  
be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

Claims 1-9 stand rejected under 35 U.S.C. 102(b) as being anticipated by  
Takeuchi for the reasons of record and for the reasons which follow.

Applicants argue that Takeuchi does not demonstrate that one can inject enzyme  
into established tumors and inhibit further growth, nor inhibit angiogenesis.

Claim 1 is drawn to a method to decrease tumor growth. Takeuchi is also treating  
tumor growth and reports that chondroitinase AC (the enzyme) inhibits tumor growth,  
see page 118, right column. Further, claim 1 does not claim injecting anything only  
administering it. In fact, claim 10 administers the enzyme topically. Applicants'  
comments concerning Takeuchi having nothing to do with angiogenesis are also not

well taken. Since Takeuchi teaches administering the enzyme and a tumor to a mouse then angiogenesis is inherently decreased.

The discovery of an inherent property of a prior art process cannot serve as a basis for patenting that process. See *Ex parte Novitski*, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993) (The Board rejected a claim directed to a method for protecting a plant from plant pathogenic nematodes by inoculating the plant with a nematode inhibiting strain of *P. cepacia*. A U.S. patent to Dart disclosed inoculation using *P. cepacia* type Wisconsin 526 bacteria for protecting the plant from fungal disease. Dart was silent as to nematode inhibition but the Board concluded that nematode inhibition was an inherent property of the bacteria. The Board noted that applicant had stated in the specification that Wisconsin 526 possesses an 18% nematode inhibition rating.).

Further, applicant argues that angiogenesis requires endothelial cells. Mice have endothelial cells. Thus the argument is moot.

### ***Claim Rejections - 35 USC § 103***

Claims 1-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi in view of JP 51075042 (JP) for the reasons of record and for the reasons which follow.

Applicants argue that Takeuchi does not demonstrate that one can inject enzyme into established tumors and inhibit further growth, nor inhibit angiogenesis.

Claim 1 is drawn to a method to decrease tumor growth. Takeuchi is also treating tumor growth and reports that chondroitinase AC (the enzyme) inhibits tumor growth, see page 118, right column. Further, claim 1 does not claim injecting anything only administering it. In fact, claim 10 administers the enzyme topically. Applicants' comments concerning Takeuchi having nothing to do with angiogenesis are also not well taken. Since Takeuchi also teaches administering the enzyme and a tumor to a mouse then angiogenesis is inherently decreased.

The discovery of an inherent property of a prior art process cannot serve as a basis for patenting that process. See *Ex parte Novitski*, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993) (The Board rejected a claim directed to a method for protecting a plant from plant pathogenic nematodes by inoculating the plant with a nematode inhibiting strain of *P. cepacia*. A U.S. patent to Dart disclosed inoculation using *P. cepacia* type Wisconsin 526 bacteria for protecting the plant from fungal disease. Dart was silent as to nematode inhibition but the Board concluded that nematode inhibition was an inherent property of the bacteria. The Board noted that applicant had stated in the specification that Wisconsin 526 possesses an 18% nematode inhibition rating.).

Further, applicant argues that angiogenesis requires endothelial cells. Mice have endothelial cells. Thus the argument is moot.

Applicants argue that JP adds nothing to the rejection since it is not known that one can reduce tumor growth retroactively. The comments concerning applicants arguments are reiterated here. Takeuchi is administering the same enzyme in the same

way as applicants. The tumor is injected into the mouse and the enzyme inhibits the tumor as noted by Takeuchi.

Claims 1-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Takeuchi and JP 51075042 for the reasons of record and for the reasons which follow.

Applicants do not even note this rejection but it is maintained. The above arguments are reiterated since they also apply here. The enzyme is known to be administered to treat tumors and will inherently perform the claimed process.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Application/Control Number:  
09/715,965  
Art Unit: 1651

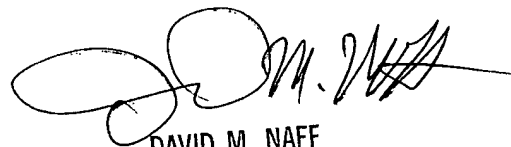
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 703-308-4230. The examiner can normally be reached on Monday thru Friday: 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

MVM  
March 29, 2002

  
DAVID M. NAFF  
PRIMARY EXAMINER  
ART UNIT 1651